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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/656,146

09/08/2003

Xavier Blin

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EXAMINER

ROGERS, JAMES WILLIAM

ART UNIT

PAPER NUMBER

1618

MAIL DATE

DELIVERY MODE

05/17/2011

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/656,146	Applicant(s) BLIN ET AL.	
	Examiner JAMES ROGERS	Art Unit 1618	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 May 2011.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 7-13, 15-18, 20-23, 26, 27, 33-39, 41-44, 46-56, 59, 83-85, 115, 119 and 120 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1,7-13,15-18,20-23,26,27,33-39,41-44,46-56,59,83-85,115,119 and 120.

Applicants amendments to the claims filed 05/02/2011 have been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1,7-13,15-18,20-23,26-27,33-39,41-44,46-56,59,83-85,115 and 119-120 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud et al. (US 5,961,998), for the reasons set forth in the previous office action filed 04/29/2008.

Claims 1,7-13,15-18,20-23,26-27,33-39,41-44,46-56,59,83-85,115 and 119-120 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arnaud et al. (US 5,961,998) in view of Willemin et al. (US 6,592,855 B1), for the reasons set forth in the previous office action filed 04/29/2008.

Response to Arguments

Applicant's arguments filed 05/02/2011 have been fully considered but they are not persuasive. Applicants assert the examiner has failed to articulate why one of ordinary skill in the art would pick and chose individual components in Arnaud to create a composition with the claimed properties.

As noted in previous office actions, several of the phenylsiloxane oils taught by Arnaud are the same oils that applicants list in their specification as having the desired high viscosity such as PCR 15M30 and PDM 1000. Furthermore the reference clearly teaches the use of low viscosity phenylsiloxane oils such as DC556, which applicants describe in their specification as a low viscosity phenylsiloxane oil. Combinations of the phenylsiloxane oils, which include the high and low viscosity siloxane oils are taught by Arnaud. See col 4 lines 17-31. Thus Arnaud teaches the claimed combination of high and low viscosity siloxane oil. The reference clearly teaches that advantageously more than one type of oil is used and the secondary oils included synthetic esters such as diisostearyl malate, which is a claimed non-volatile ester oil. Furthermore the

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combination of phenylsiloxane oil and the ester oil tridecyl trimellitate are claimed, thus the two oils are within the claimed subject matter of the patent. Arnaud clearly teaches all of applicants claimed ingredients and would be a 102 type of anticipatory reference if not for applicants claimed range of high viscosity phenylsiloxane oil, but this range as noted in previous office actions overlaps the claimed range and therefore would have been obvious, see MPEP § 2144.05. Additionally as described in previous office actions it would have been obvious to combine a high and low viscosity phenylsiloxane from the disclosure of Arnaud alone or in view of Willemin since they were disclosed as being used for the same purpose and the addition would not change the respective functions of the oils within the composition. The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. KSR, 550 U.S. at ___, 82 USPQ2d at 1395.

Applicants disagree with respect to the examiners rationale that the declaration does not show unexpected results. Applicants argue that other properties besides “non-greasy and hard lipstick” were evaluated in the declaration filed 12/1/2010 include hardness, stability of sticks after 24 hours at various temperatures, homogeneity of deposit on bioskin, texture, level of wear of glossiness and level of wear of color. Applicants argue selection of a lipstick with the properties above is not described in Arnaud. Applicants further argue that the declarations provide enough examples to

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allow the skilled artisan to determine a trend in the data and reasonably extend the probative value thereof. Thus applicants surmise that the evidence of non-obviousness is commensurate with the scope of the claims.

There are three reasons the examiner does not find applicants declarations persuasive 1) the declarations do not compare applicants claimed invention to the closest prior art, Arnaud 2) the declarations are not commensurate with the scope of the claims and 3) the declarations do not show unexpected results,

As noted in previous office actions the declaration does not compare applicants claimed invention with the closest prior art Arnaud. Arnaud as noted in previous office actions claims and exemplifies the same ester oil claimed by applicant, tridecyl trimellitate. The only reason Arnaud is not a 102 type of rejection is because of applicants claimed amounts of the high viscosity phenylsiloxane oil, Arnaud discloses an overlapping amount range but not a range within the claimed amounts.

The examples within applicant's declarations are all drawn to lipstick compositions that are much narrower in scope than what is actually claimed. For instance compositions 1-3 in the declaration filed 10/05/2009 each contain only one specific commercially sourced low viscosity phenyl siloxane with a specific structure and MW whereas the low viscosity oil of claim 1 reads on any phenylsiloxane which has a viscosity lower than 500 cst. Additionally compositions 1-3 only contain one specific commercially sourced high viscosity phenyl siloxane of a specific structure and MW wherein the high viscosity oil of claim 1 can be any phenylsiloxane within the scope of formula (A) which has a viscosity greater than 500 cst. Additional ingredients within the

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lipstick composition not required in the claimed composition include microcrystalline cellulose, alkyl dimethicone, Microwax from paramelt and mixtures of glycerides.

Applicants argument with respect to the unexpectedness resulting in selecting ingredients of a lipstick with the disclosed properties of hardness, stability of sticks after 24 hours at various temperatures, homogeneity of deposit on bioskin, texture, level of wear of glossiness and level of wear of color is not persuasive. The declarations evaluations of the properties in a lipstick is routine experimental optimization of components which give the best properties for a lipstick cosmetic such as stability, homogeneity, texture, color etc. Lipsticks in general would be expected to function for their intended use as a cosmetic which would mean it would be capable of being deposited on the skin, have good stability, good texture, color, etc. Arnaud does mention that pigments are added to add color, fillers and pearlescent agents are added to modify the texture of the composition, waxes and gums are added to achieve the desired mechanical properties and the desired textures. Arnaud also states that the nature of the additional ingredients and their proportion must be compatible with the production of **stable**, thickened and **glossy** compositions according to the invention. Furthermore the invention of Arnaud can be a tube of lipstick, a lip gloss, which can be used as it is or applied to a film of lipstick, in particular in order to **increase its gloss** and/or to **reduce the migration of the oils** (top coat). Arnaud specifically states that the cosmetic achieves satisfactory cosmetic properties (glossy and stable composition) without the drawbacks of previous cosmetic compositions including migration of the cosmetic, oil exudation from the cosmetic, poor staying power, lack of glossiness on

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account of waxes which increase matt, non-uniform film (pigment not evenly distribute)

See col 1 lines 21-63, col 2 lines 8-20, col 4 lines 52-63, col 7 lines 26-41. Thus contrary to applicants arguments deposition, stability, texture, color, homogeneity were known properties that had issues which the Arnaud patent identified and gave sought to rectify by using the combination of ingredients described within. Thus contrary to applicant's arguments these parameters were known to be adjusted by selecting components in amounts that led to the most desirable form. Therefore the examiner maintains that the declaration does not show unexpected results but rather expected results garnered through routine and obvious optimization.

Conclusion

No claims are allowed at this time.

Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to James W. Rogers, Ph.D. whose telephone number is (571) 272-7838. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mike Hartley can be reached on (571) 271-0616. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/J. R./
Examiner, Art Unit 1618

/MICHAEL G. HARTLEY/

Supervisory Patent Examiner, Art Unit 1618